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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,900	10/25/2001	Peter Worthington Hamilton	8762	7654

27752 7590 08/04/2003

THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION
WINTON HILL TECHNICAL CENTER - BOX 161
6110 CENTER HILL AVENUE
CINCINNATI, OH 45224

EXAMINER

SIMONE, CATHERINE A

ART UNIT PAPER NUMBER

1772

DATE MAILED: 08/04/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/003,900

Applicant(s)

HAMILTON ET AL.

Examiner

Catherine Simone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Withdrawn Rejections

1. The 35 U.S.C. 112 rejection of claims 1-19 of record in Paper #5, Page 2, Paragraph #2 has been withdrawn due to the Applicant's amendment in Paper #7.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over McGuire et al. (5,965,235).

Regarding **claims 1 and 2**, McGuire et al. discloses a storage wrap material comprising a sheet material having a first active side and a second side (see col. 3, lines 1-10), the first active side comprising a plurality of three-dimensional non-adherent protrusions (Fig. 9, #12) extending outwardly from surrounding depressions (Fig. 9, #14) and an adhesive composition coating on at least a portion of the depressions (Fig. 9, #16). McGuire et al. teaches the adhesive coating composition having a thickness less than the height of the non-adherent protrusions and preferably about 0.001 inch (0.025 mm) thick and even more preferably between about 0.0005 inch (0.013 mm) and 0.002 inch (0.051 mm)(see col. 17, lines 30-45). However, McGuire et al. fails to teach the specific ranges for the thickness of the adhesive coating composition as recited

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in claims 1 and 2 of the present invention. The thickness of the adhesive coating composition would be readily determined through routine experimentation by one having ordinary skill in the art depending on the desired end results. There is no indication in McGuire et al. that the thickness of the adhesive coating composition cannot be in the range from about 0.00001 inches (0.00025 mm) to about 0.0002 inches (0.0051 mm). Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have the adhesive coating composition with a thickness from about 0.00001 inches (0.00025 mm) to about 0.0002 inches (0.0051 mm), since it has been held that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Regarding **claims 5 and 6**, the adhesive composition coating covers less than 75% of the first active side of the sheet material (see col. 20, lines 1-5). Regarding **claims 7-9**, note the first active side is activatable by an externally applied force exerted upon the sheet material (see col. 16, lines 63-67 and col. 17, lines 1-4). Regarding **claim 12**, note the second side comprises an active side (see col. 3, lines 7-10). Regarding **claim 15**, the sheet material comprises a polymeric film material (see col. 17, lines 56-60).

Regarding **claims 16-20**, process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173

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USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitations in claims 16-20 are methods of production and therefore do not determine the patentability of the product itself.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,194,062. Although the conflicting claims are not identical, they are not patentably distinct from each other because the

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claims and the specification of U.S. Patent 6,194,062 are broad enough to encompass or include that which is recited in the present patent application.

Hamilton et al. discloses a storage wrap material comprising a sheet material having a first active side and a second side, the first active side comprising a plurality of three-dimensional non-adherent protrusions extending outwardly from surrounding depressions (Fig. 3, #12) and an adhesive composition coating on at least a portion of the depressions (Fig. 3, #16), wherein the adhesive composition coating (Fig. 3, #16) has a thickness less than the height of the non-adherent protrusions. However, Hamilton et al. fails to disclose the adhesive coating composition having a thickness from about 0.00001 inches (0.00025 mm) to about 0.0002 inches (0.0051 mm). The thickness of the adhesive coating composition would be readily determined through routine experimentation by one having ordinary skill in the art depending on the desired end results. There is no indication in Hamilton et al. that the thickness of the adhesive coating composition cannot be in the range from about 0.00001 inches (0.00025 mm) to about 0.0002 inches (0.0051 mm). Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have the adhesive coating composition with a thickness from about 0.00001 inches (0.00025 mm) to about 0.0002 inches (0.0051 mm), since it has been held that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

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Response to Arguments

6. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

The case law used in the U.S.C. 103 rejection of record in Paper #5, Pages 2-4, Paragraph #4 was ^mimproper. Therefore, a new rejection is noted above.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (703) 605-4297.

The examiner can normally be reached on 9:30-6:00.

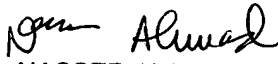
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (703) 308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

CAS

Catherine Simone
Examiner
Art Unit 1772

July 28, 2003


NASSER AHMAD
PRIMARY EXAMINER
Acting SPE